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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

WILLETT, STEPHAN F

ART UNIT PAPER NUMBER

2142

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/855,216

Applicant(s)

SCHROATH, LEONARD T.

Examiner

Stephan F. Willett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-22,24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-22,24 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 21 is/are objected to because of the following informalities: It does not have a dependency. Appropriate correction is required.

Claim Rejections - 35 USC 103

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103 and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7, 9-22, 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parathasarathy et al. with Patent Number 6,347,398 in view of Hurtado et al. with Patent Number 6,611,812.

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5. Regarding claim(s) 1, 10, 19, Parathasarathy teaches using a computer network to download software to a user. Parathasarathy teaches providing a user interface to allow a user to identify a device, col. 7, lines 26-31 and locating the interface at a plurality of selectable devices and/or based on associated files relevant to a device selected by the user, col. 9-10, lines 60-3; col. 9, lines 3-5, as does Hurtado at col. 25, lines 36-39. Parathasarathy teaches identifying or offering a particular device via an interface, col. 7, lines 58-61. Parathasarathy teaches accessing software specific to the device, col. 7, lines 37-43. Parathasarathy teaches storing the software and making the software available to the user, col. 8, lines 13-17. Parathasarathy teaches a first server and a software server in communication to download software, col. 14, 15, lines 21-23, 39-47. Parathasarathy teaches the invention in the above claim(s) except for explicitly teaching locating the user interface in a retail sales location where the device is offered to be sold. In that Parathasarathy operates to download software for particular device and files, the artisan would have looked to the downloading arts for details of implementing software downloads. In that art, Hurtado, a related network software downloading, teaches "example[s of] on line Electronic Digital Store(s) are Web Sites that provide electronic downloads of software", col. 12, lines 63-64 in order to provide desired software. Hurtado specifically teaches wholesale and retail purchase can be implemented, col. 15, lines 8-19. Further, Hurtado suggests "Digital Content Retail Stores", col. 73, line 34 will result from implementing their system. The motivation to incorporate retail sales with the product device insures that required software can be sold with the device. Thus, it would have been obvious to one of ordinary skill in the art to incorporate the retail stores as taught in Hurtado into the software downloading system described in the

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Parathasarathy patent because Parathasarathy operates with commercial entities and Hurtado suggests that optimization can be obtained with retailers.

1. Regarding claim(s) 4-5, 11-12, 14, Parathasarathy teaches automatically accessing and storing the software, col. 8, lines 14-15.
2. Regarding claim(s) 6, Parathasarathy teaches connecting to a global network, col. 7, line 9.
3. Regarding claim(s) 7, 16, 22, Parathasarathy teaches the software is associated with an address and connecting to said address based on the selected device or software desires, col. 8, lines 31-34.
4. Regarding claim(s) 9, 15, 18, Parathasarathy teaches providing electronic copies on disk of the software, col. 4, lines 39-40, col. 9, lines 41-42.
1. Regarding claims 2-3, 13, 17, Hurtado teaches legacy menus of software devices and manufacturers to choose desired software products, col. 70, lines 50-53.
2. Regarding claim(s) 24-25, Parathasarathy teaches optic media, col. 4, lines 39-40.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U. S.C. 102(e) that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 10-12, 14-16, 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Parathasarathy et al. with Patent Number 6,347,398.

7. Regarding claim(s) 10, Parathasarathy teaches using a computer network to download software to a user. Parathasarathy teaches providing a user interface to allow a user to identify a device, col. 7, lines 26-31 and locating the interface at a plurality of selectable devices and/or based on associated files relevant to a device selected by the user, col. 9-10, lines 60-3; col. 9, lines 3-5. Parathasarathy teaches identifying or offering a particular device via an interface, col. 7, lines 58-61. Parathasarathy teaches accessing software specific to the device, col. 7, lines 37-43. Parathasarathy teaches storing the software and making the software available to the user, col. 8, lines 13-17. Parathasarathy teaches a first server and a software server in communication to download software, col. 14, 15, lines 21-23, 39-47.

8. Regarding claim(s) 11-12, 14, Parathasarathy teaches automatically accessing and storing the software, col. 8, lines 14-15.

9. Regarding claim(s) 16, Parathasarathy teaches the software is associated with an address and connecting to said address based on the selected device or software desires, col. 8, lines 31-34.

Regarding claim(s) 15, 18, Parathasarathy teaches providing electronic copies on disk of the software, col. 4, lines 39-40, col. 9, lines 41-42.

Claim Rejections - 35 USC 103

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103 and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 13, 17, are rejected under 35 U.S.C. 103(a) as being unpatentable over Parathasarathy et al. with Patent Number 6,347,398.

6. Regarding claims 13, 17, the Parathasarathy patent discloses the method of the preceding claims. The Parathasarathy patent does not explicitly disclose legacy menus of software devices and manufacturers to choose desired software products by touch. However, Official Notice is taken MPEP 2144.03 (a) that menus to touch select software products are well known in the art to insure the desired software is obtained. It would have been obvious to one of ordinary skill in the art at the time of the application's invention to provide touch menu selections of software products to obtain the advantages of a user friendly application. By the above rational, the claim is rejected.

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1. Based on the new grounds for rejection the applicants' arguments are moot. The broad claim language used is interpreted on its face and based on this interpretation the claims have been rejected.

2. The limited structure claimed, without more functional language, reads on the references provided. Thus, Applicant's arguments can not be held as persuasive regarding patentability.

3. Applicant suggests "Parathasarathy does not disclose each and every limitation of Applicant's claim 10", Paper Filed 2/14/05, Page 10, line 11. However, Parathasarathy teaches locating the interface at a location of plurality of selectable devices and/or based on associated files relevant to a device selected by the user, col. 9-10, lines 60-3; col. 9, lines 3-5. In addition, Hurtado teaches "example[s of] on line Electronic Digital Store(s) are Web Sites that provide electronic downloads of software", col. 12, lines 63-64; wholesale and retail purchase can be implemented, col. 15, lines 8-19, "Digital Content Retail Stores", col. 73, line 34, and legacy menus of software devices and manufacturers to choose desired software products, col. 70, lines 50-53. Thus, Applicant's arguments can not be held as persuasive regarding patentability.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is disclosed in the Notice of References Cited. A close review of the references is suggested. A close review of the Savage reference with Patent Number 6,847,937 is suggested. The other references cited teach numerous other ways to download software to also retail clients, thus a close review of them is suggested.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this

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Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP: 706:07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

5. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephan Willett whose telephone number is (571) 272-3890. The examiner can normally be reached Monday through Friday from 8:00 AM to 6:00 PM.

7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey, can be reached on (571) 272-3896. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

8. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

sfw

April 23, 2005


BEATRIZ PRIETO
PRIMARY EXAMINER